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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,592	08/17/2001	Jonathan O. Nelson	109909-129556	5217
25943	7590	02/09/2005	EXAMINER	
SCHWABE, WILLIAMSON & WYATT, P.C. PACWEST CENTER, SUITES 1600-1900 1211 SW FIFTH AVENUE PORTLAND, OR 97204			NGUYEN, LEE	
			ART UNIT	PAPER NUMBER
			2682	

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,592

Applicant(s)

NELSON, JONATHAN O.

Examiner

LEE NGUYEN

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-44 and 59-64 is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-26 and 45-58 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the communication filed 09/17/2004.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15, 17-26, 45-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (US 6,539,240) in view of Schneider (US 2002/0156866).

Regarding claim 1, Watanabe teaches an apparatus (fig. 1), comprising: a display 21; a first input key 20; and operating logic 14 associated with the first input key to display on said display one or more emotion image for selection by a user, responsive to a selection of said first input key, when the apparatus is operating in a text mode (col. 6, 19-53, col. 7, 64 through col. 8, 61). Watanabe differs from the claimed invention in that the well-known emoticons are used rather than the emotion image. In contrast, Schneider teaches that emoticons can be used to express user's feeling for

use in a communication network (see [0020], [0077], [0078], [0083], [0107] and figs. 2, 10-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the emotion image of Watanabe with the emoticons of Schneider in order to reduce bandwidth consumption in the communication system.

Regarding claims 2-3, Watanabe fails to teach that the first input key is an input key for entering an "*" (asterisk), a "#" when the apparatus is operating in a voice mode. However, as suggested by Watanabe the input key can be dial key, communication key, OFF key, REPRODUCE key, cursor key and more (col. 5, 57-61). Consequently, the first input key of Watanabe can also be either an "*" (asterisk) or a "#". It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the "*" (asterisk) or a "#" keys into the first input key of Watanabe so that the user can easily select the desire emoticon.

Regarding claim 4, Watanabe as modified also teaches that first input key is an input key for entering a digit when the apparatus is operating in a voice mode (dial key, col. 5, 58).

Regarding claims 5-9, Watanabe as modified fails to teach 4*3 array of the 12 input keys as claimed. However, first Watanabe suggests that the key could be dial key (col. 5, 58) and that the telephone could be a PHS, PSTN, portable phone and more (col. 14, 46-51), which inherently includes the array arranged as claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the array arrange as claimed so that the user can operate the keypad conveniently according to the conventional keypad.

Regarding claim 10, Watanabe as modified fails to teach that said operating logic is designed to display said emoticons for selection in a selected one of a first left-to-right then top-to-bottom display arrangement, a second right-to-left then top-to-bottom display arrangement, a third top-to-bottom then left-to-right display arrangement, and a fourth top-to-bottom then right-to-left display arrangement. As to that limitation it was held that there would be no invention in shifting an object to a different position since the operation of the device would not thereby be modified.

Regarding claims 11-13, Watanab as modified fails to teach high lining (the claimed current focus) the selected items and selecting the selected items.

It is taken official notice in the art of selecting highline items is conventionally well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide selecting highline items in the apparatus of Watanabe in order to save spaces of the unnecessarily extra keys.

Regarding claims 14-15, 17, Watanabe as modified teaches that said first input key is also employed to provide said user input and at least one other input key, and said at least one other input key is employed to provide said user input (col. 8, 49-61).

Regarding claim 18, Watanabe as modified also teaches that each of said one or more emoticons comprises a plurality of characters (Scheider, [0083]).

Regarding claims 19-21, the claims are interpreted and rejected for the same reason as set forth in claim 11.

Regarding claim 22, Watanabe as modified also teaches that each of said one or more emoticons comprises a pixel map based single graphical symbol (col. 6, 48).

Regarding claim 23, Watanabe as modified also teaches that said apparatus further comprises: storage medium 18a having stored therein a plurality of programming instructions designed to implement said operating logic; and a processor 14 coupled to the storage medium to execute the programming instruction.

Regarding claims 24-25, Watanabe as modified also teaches that said apparatus is a communication device or a wireless mobile phone (col. 14, 46-51).

Regarding claim 26, Watanabe as modified fails to teach add or delete the emoticon. It is taken official notice that the art of add or delete an object in

a display of a portable device is conventionally well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add or delete emoticon in the apparatus of Watanabe so that the user can have his desire emoticons.

Regarding claims 45, 52, Watanabe teaches a communication device cover (fig. 1), comprising: a plurality of input keys 20 including first input key (col. 5, 57-61); and storage medium 18a having stored therein a plurality of programming instructions designed to enable a communication device mated with the communication device cover to display on a display of the communication device one or more emotion image for selection responsive to a selection of said first input key (col. 6, 19-53, col. 7, 64 through col. 8, 61).). Watanabe differs from the claimed invention in that the well-known emoticons are used rather than the emotion image. In contrast, Schneider teaches that emoticons can be used to express user's feeling in the communication (see [0078], [0083], [0107] and figs. 2, 10-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the emotion image of Watanabe with the

emoticons of Schneider in order to reduce bandwidth consumption in the communication system.

Regarding claims 46, 53, the claims are interpreted and rejected for the same reason as set forth in claim 11.

Regarding claims 47, 54, the claims are interpreted and rejected for the same reason as set forth in claim 12.

Regarding claims 48, 55, Watanabe as modified also teaches that said programming instructions further enable the mated communication device to select the emoticon with the current focus, in a selected one of an automatic manner (col. 7, 47) and a responsive to user input manner (col. 8, 49-56).

Regarding claims 49, 56, Watanabe as modified also teaches that said storage medium further having stored therein a plurality of emoticons (col. 8, 49-56).

Regarding claims 50, 57, Watanabe as modified also teaches that said storage medium further having stored therein information identifying said first input key (col. 5, 26-33).

Regarding claims 51, 58, the claims are interpreted and rejected for the same reason as set forth in claim 18.

Allowable Subject Matter

3. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 16, the prior art of record fails to teach that said operating logic is further designed to automatically select the emoticon with the current focus upon occurrence of a selected one of elapse of a predetermined amount of time after the first input key was last selected,

and selection another input key.

4. Claims 27-44, 59-64 are allowed.

Regarding claim 27, the prior art of record either alone or in combination fails to teach responsive to a selection of said first input key, and to automatically select the emoticon having the current focus upon expiration of a predetermined amount of time since the current focus was placed.

Regarding claim 59, the method claim is allowable for the same reason as set forth in the apparatus claim 27.

Response to Arguments

5. Applicant's arguments filed 09/17/2004 have been fully considered but they are not persuasive.

Applicant argues that Watanabe fails to teach the requirement in which the selection is made from **a selection list (of the emoticons)**, which is displayed in response to **the selection of a particular key of the apparatus**.

In response, the term **a selection list (of the emoticons)** is not claimed. The term “to display on said display one or more emoticons for selection by a user” can be read as one emoticon to be displayed, and there is not list whatsoever required by the claim. Second, assume arguendo that the claim requires a selection list of emoticons which is displayed in response to the selection of a particular key of the apparatus, Watanabe does disclose this limitation. Referring to column 8, lines 52-56, Watanabe teaches:

If it is determined at step A17 that a predetermined key has been operated, an image of the character taking an action corresponding to the operated key (or a sequence of images corresponding to the action) is selected and read out (step A18).

Therefore, a sequence of images corresponding to a predetermined key is displayed for selection. Consequently, the combination of Watanabe and Schneider do teach the claimed limitation.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) 308-6739.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 1/24/05
LEE NGUYEN
Primary Examiner
Art Unit 2682